

REMARKS

Claims 35–45 are pending in this application. By this Amendment, claims 1–4 and 32–34 are canceled, and claims 35–45 are added. New claims 35–41 respectively correspond to canceled claims 1–4 and 32–34. New claims 42–45 find support, for example, in original claim 7 and read on the elected species. No new matter is added.

In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

I. Rejection under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 1–4 and 32–34 as being indefinite under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse the rejection.

The Office Action asserts that the mere recitation of the molecular compound being derived from the reaction of a phenolic derivative and organic compounds as now defined still does not provide sufficient clarity to one of ordinary skill in the art to determine the chemical structure of the resulting molecular compound.

It is well settled that the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279 (CCPA 1979); MPEP §2113.

The attached Declaration attests that because the claimed compounds are molecular compounds, they cannot be structurally defined. The Declaration cites to Encyclopaedia Chimica (ISBN: 4-320-04022-8, published September 20, 1997) (copy attached), which defines a molecular compound as follows:

Molecular Compound

-- is a compound formed by a direct bond of molecules of compounds A and B which [the compounds A and B] can exist stably alone, and where the bond between A and B is the one which cannot be explained by classical structural theories.

The Declaration further attests that because the recited molecular compounds are a complex, the best way to define the molecular compounds is to define them by the production process. Using product-by-process claims to define molecular compounds has been previously found patentable, as evidenced by U.S. Patent No. 5,364,977, where a clathrate compound is defined by a production process in which the clathrate compound is produced by reacting tetrakisphenol and an organic compound.

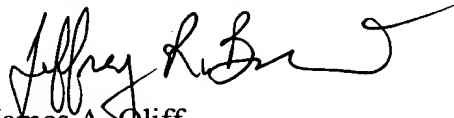
For at least these reasons, Applicants respectfully submit that the claims are not indefinite. Accordingly, reconsideration and withdrawal of the rejection are requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:JRB

Attachments:

Declaration under 37 C.F.R. §1.132
Encyclopaedia Chimica, page 183 (ISBN: 4-320-04022-8, published September 20, 1997)

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